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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of)
PATRICK ARACHEQUESNE)
Serial No.: 10/791,827)
Filed: March 4, 2004)
For: MOUNTING A)
HOLOGRAPHIC SIGHT)
ON A FIREARM)

Group Art Unit 3641
Michelle Renee Clement, Examiner

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Patricia Oakes, Secretary to Edward G. Greive

REPLY BRIEF PURSUANT TO 37 C.F.R. 41.41

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply to the Examiner's Answer mailed March 3, 2009.

Status of claims begins on page 2 of this paper.

Grounds of rejection to be reviewed on appeal begin on page 3 of this paper.

Arguments begin on page 4 of this paper.

Status of claims

Claims 1-48 and 57 have been cancelled. Claims 49-56 and 58-60 have been rejected under 35 U.S.C. § 103, and are all appealed.

The Examiner's Answer acknowledges that this statement of the status of the claims, which is contained in Appellant's Amended Appeal Brief, is correct.

Grounds of rejection to be reviewed on appeal

Claims 60 and 56 have been rejected¹ under 35 U.S.C. § 103(a) as being unpatentable over Booth ("Booth", U.S. Patent No. 6,671,990) in view of Tai et al. ("Tai '362", U.S. Patent No. 5,483,362). Non-patent literature was also cited² in the rejection of these claims.

Claims 49-55, 58, and 59 have been rejected³ under 35 U.S.C. § 103(a) as being unpatentable over Booth and Tai '362 as applied to claim 60, and further in view of Sanders ("Sanders", U.S. Patent No. 5,046,277) and Tai et al. ("Tai '060", U.S. Patent No. 6,490, 060).

The rejection of all claims was confirmed in the Advisory Action mailed 1/18/2008.

The Examiner's Answer acknowledges that this statement of the grounds of rejection to be reviewed on appeal, which is contained in Appellant's Amended Appeal Brief, is correct.

¹ Final Office Action mailed 9/11/2007 at paragraph 4.

² *Id.* These non-patent literature references are listed on the Notice of References Cited mailed with the Final Office Action (9/11/07), and include: (U) <http://www.opticsplanet.net/bushnell-holosight.html> (pgs. 1-5), (V) Ultimak (<http://ultimak.com/UnderstandingE-sights.htm>) (pgs. 1-14), (W) Holographic Weapon Sight Product Introduction, NDIA/EOTech presentation, June 2004, (X) Knights Armament Company (<http://www.defensereview.com/article106.htm>) (pgs. 1-3), and (U-page 2) National Defense (<http://www.nationaldefensemagazine.org/issues/2004/Sep/Holographic.htm>) (pgs. 1-2). Copies of these non-patent literature references are included in Appendix B to this Appeal Brief.

³ *Id.* at paragraph 5.

Argument

As a preliminary matter, the Examiner has asserted that the summary of claimed subject matter contained in the Amended Appeal Brief is deficient. However, the portions of the brief referred to included changes to that section of the brief which were made specifically in response to the Examiner's Notification of Non-Compliant Appeal Brief mailed October 30, 2008, which stated at ¶ 10 that:

With regards to No. 4 above, the brief fails to identify and/or set forth the structure, material, or acts described in the specification for each dependent claim argued separately, every means plus function corresponding to each claimed function.

The Appellant took this to refer to dependent claim 49, which recites "removably mounting means." Appellant had not included a description of that claim in the originally filed Appeal Brief because Appellant considers it a recitation of structure, and not a means for performing a specified function as contemplated under 35 U.S.C. § 112, sixth paragraph. In view of the Examiner's Answer, it seems the Examiner agrees – that "removably mounting means" is a recitation of a structural feature that does not invoke 35 U.S.C. § 112, sixth paragraph.

Turning to the rejections, the Examiner has made an assertion that is unsupported by the cited references. At pages 7 and 12, the Examiner claims that "it is well known for sighting devices and other devices to be mounted at all locations on a barrel." Appellant disagrees. The gun-sight arts, including those cited by the Examiner, do not teach an important and distinguishing feature of the claimed invention – mounting a holographic sight at or near the muzzle end of a firearm.

Appellant also disagrees with the Examiner's assertion at page 9 that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." A *prima facie* case of obviousness requires that the prior art references, when combined, must teach or suggest *all* the claim limitations. *In re Vaeck*, 947 F.2d 448, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has admitted that "none of the references individually show a firearm having a holographic sight mounted on the firearm closer to the muzzle end than the opposite end." Page 9. Because none of the references teach or suggest a holographic sight device mounted on a firearm closer to the muzzle end of the barrel than the opposite end, a *prima facie* case

of obviousness has not been established.

Appellant also disagrees with the Examiner's assertion at pages 5 that the claims include statements of intended use. As discussed in section VII(a) of the Amended Appeal Brief, the claims, including those that recite "wherein," define the structural features of the invention.

Finally, the Appellant disagrees with the extremely liberal construction given to the limitation "essentially parallel" by the Examiner. Claim 51 recites a groove direction that is essentially parallel to the longitudinal direction of the barrel. The Examiner's assertion that the inclined ramp shown on page 8 of the brief is essentially parallel to the gun barrel is wrong, and the claimed feature is not shown.

For all of these reasons, and the reasons in Appellant's Amended Appeal Brief, the Examiner's rejections should be reversed.

Respectfully submitted,



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